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10/660,872

09/11/2003

Hiroshi Kanno

FUJI 20.625

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/660,872

**Applicant(s)**

KANNO ET AL.

**Examiner**

JAGDISH N. PATEL

**Art Unit**

3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to amendment filed 10/15/08.

#### ***Response to Amendment***

2. Claims 1 and 2 have been amended and new claims 16-19 have been added.

#### ***Specification***

3. The abstract of the disclosure is accepted.

#### ***Priority***

4. Since the applicant not provided any evidence that the PCT publication was published in English and designating the U.S., no benefit of priority is accorded to application of International Application PCT/JP01/01964. Accordingly, effective date for the application is considered as the U.S. filing date (Sept. 11. 2003).

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejections.

The applicant's only argument is that the Jacob et al . does not disclose or suggest that the mobile unit 312 comprises a memory configured to be able to store data of charge from an input device at least until report data is received by a second

reception unit as recited in claims 1 and 2. However, this argument is not persuasive because Jacob et al teaches a memory unit within the mobile unit 12 which comprises a memory configured to store the data (see at least p. 7, second paragraph, last four lines).

The amended claim introduces 112(second) indefiniteness as explained below.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites amended limitation “an a settlement input device configured to output data of a charge based on input data of items or a service to be purchased.”

However, the structure of the input device does not recite any element to input the requisite data. This renders the claim indefinite because the source of the input data cannot be ascertained.

Similarly, claim 1 fails to specify any structural element via which it receives identification data of the mobile communication terminal which is transmitted to the settlement device via the second transmission unit.

No communication link of the input device specified with the mobile communication terminal is via the mobile communication network to which the mobile communication terminal is connected?

The amended claim further recites limitation "report data of the amount of transferred money" which lacks positive antecedent basis. Is this same as "an amount of money determined " as referenced in the preceding limitation "a control unit"?

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs et al.

Jacob teaches as per claim 1 and 2:

A settlement system, comprising:

a mobile communication terminal connectable with a mobile communication network;

(Fig. 7, element 312)

a input device configured to output data of a charge based on input data of items or a service to be purchased;

(Fig. 7, element Cashier Register 314)

and

a settlement device able to communicate with the mobile communication terminal through the mobile communication network and able to communicate with the input device, and able to transfer money from a first account to a second account,

(Fig. 7, element Financial Transaction Clearing House 318)

wherein the input device comprises:

a first transmission unit configured to transmit the data of the charge to the mobile communication terminal; and

(Fig. 7, p. 10-13, refer to functionality of Cashier Register 314 described in Fig. 1-6)

a second transmission unit configured to transmit the data of the charge, identification data of the mobile communication terminal, and identification data of the input device to the settlement device;

(Fig. 7, p. 10-13, refer to functionality of Cashier Register 314 described in Fig. 1-6)

the settlement device comprises:

a control unit configured to transfer an amount of money determined by the data of the charge from the first account determined by the identification data of the mobile communication terminal received from the input device to the second account determined by the identification data of the input device;

(Fig. 7, p. 10-13, refer to functionality of Financial Transaction Clearing House 318 described in Fig. 1-6)

and

a transmission unit configured to transmit report data of the amount of transferred money to the mobile communication terminal through the mobile communication network; and

(Fig. 7, p. 10-13, refer to functionality of Financial Transaction Clearing House 318 described in Fig. 1-6)

the mobile communication terminal comprises:

a first reception unit configured to receive the data of the charge from the input device;

(Fig. 7, p. 10-13, refer to functionality of Mobile Unite 312 described in Fig. 1-6)

a second reception unit configured to receive the report data of the amount of the transferred money from the settlement device; and

(Fig. 7, p. 10-13, refer to functionality of Mobile Unite 312 described in Fig. 1-6)

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a display configured to display the data of the charge and the report data of the amount of transferred money.

(Fig. 7, p. 10-13, refer to functionality of Mobile Unite 312 described in Fig. 1-6).

Whereas, Jacobs et al. teaches a memory unit as integral part of the Mobil communication unit, (see at least p. 7, second paragraph, last four lines). such memory is not configured to be able to store the data from the input device. However, the examiner asserts that storing transaction data and charge confirmation data in a user terminal (such as a user computer or terminal) is matter of common sense and/or ordinary ingenuity. Since, one of ordinary skill in the art would recognized that providing a memory unit configured to be able to store any data pertinent to charge provides benefit that such data can be retrieved for future use and retrieval for any reason such as charge reconciliation, record keeping, dispute resolution etc. (KSR International Co. v. Teleflex Inc. 550 U.S. -, 82 USPQ2d 1835 (2007)).

2. A mobile communication terminal connectable with a mobile communication network and able to communicate with an input device for outputting data of a charge based on input data of items or service to be purchased and a settlement device able to transfer money from a first account to a second account through the mobile communication network in response to receiving the data of the charge from the input device, the mobile communication terminal comprising:

a first reception unit configured to receive the data of the charge from the settlement input device;

a second reception unit configured to receive report data of an amount of transferred money from the settlement device through the mobile communication network; and

a display configured to display the data of the charge and the data of the amount of the transferred money and

(Fig. 7, p. 10-13, refer to functionality of Mobile Unite 312 described in Fig. 1-6 in conjunction with Fig. 7)



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Whereas, Jacobs et al. teaches a memory unit as integral part of the Mobil communication unit, (see at least p. 7, second paragraph, last four lines). such memory is not configured to be able to store the data from the input device. However, the examiner asserts that storing transaction data and charge confirmation data in a user terminal (such as a user computer or terminal) is matter of common sense and/or ordinary ingenuity. Since, one of ordinary skill in the art would recognized that providing a memory unit configured to be able to store any data pertinent to charge provides benefit that such data can be retrieved for future use and retrieval for any reason such as charge reconciliation, record keeping, dispute resolution etc. (KSR International Co. v. Teleflex Inc. 550 U.S. -, 82 USPQ2d 1835 (2007)).

### ***Allowable Subject Matter***

Claims 18 and 19 are deemed allowable over prior art of record if written in independent form.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE **FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693